

REMARKS

Claims 1-4, 7-14, 17-25, 27 and 28 are pending. Claims 1-4, 7-14, 17-25, 27 and 28 were rejected. By virtue of this response, no claims are cancelled, no claims are amended, and no new claims are added. Accordingly, claims 1-4, 7-14, 17-25, 27 and 28 are currently under consideration.

For the Examiner's convenience, Applicants' remarks are presented in the same order in which they were raised in the Office Action.

Double Patenting

Claims 1-28 are rejected under the judicially created doctrine of double patenting over claims 1-23 of U.S. Patent No. 6,651,086 B1 since allegedly the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Applicants are prepared to file a terminal disclaimer in the present application upon a determination of allowable subject matter as presently claimed.

Claim Rejections Under 35 USC §103

Claims 1-4, 7-14, 17-25, 27-28 are rejected under 35 U.S.C. §103 as allegedly being unpatentable over Barrett et al [Barrett 6,400,381B1] in view of Shtiveman [6,346,952 B1].

For ease of reference, claim 1 is provided in full:

"A method, in a messaging server, of connecting parties with mutual interests, comprising the steps of:

providing a media object to be displayed to a first user;
receiving a first comment from the first user;
providing the media object to be displayed to a second user along with the first comment;
receiving a reply comment from the second user wherein the first user and the second user are not connected to an instant messaging session; and
if the reply comment fits a matching criteria, automatically connecting the first and the second user in an instant messaging system."

In rejecting this claim, the Examiner relies on Barrett, Col. 5, Lines 15-25, Col 5, Lines 1-15, and Col. 6, Lines 1-27. Col. 5, Lines 15-25 is said to teach “providing a media object to be display [sic] to a first user,” and the Examiner appears to identify the chat window itself as teaching this limitation. Col. 6, Lines 1-27 are said to teach “providing the media object to be displayed to a second user along with the first comment” and the Examiner points to the “documents accessed by a first client computer” as the media object there. Paper No. 20051123 at page 4.

Applicants respectfully submit that two different items of Barrett have separately been identified as a “media object” according to claim 1. The first time, the chat window appears to be identified as the media object, and the next time, “documents” appear to be identified as the media object. Applicants submit that it is inappropriate to identify two completely different and separate items in Barrett (chat window & documents) in meeting a single “media object” recitation in claim 1.

Applicants respectfully point out that claim 1 recites (1) that a “media object” is provided to be displayed to a first user and (2) that the media object is further provided to be displayed to a second user, along with a comment received from the first user, and (3) a reply comment from the second user is received while the first user and the second user are not connected to an instant messaging session. Applicants submit that even the proposed combination of elements does not meet the above claim 1 recitations because there is no teaching of Barrett that (1), (2), and (3) all occur where users are not connected to an instant messaging session.

Col. 5, Lines 1-15 are said to teach “receiving a first comment from the first user” because “the client applet identifies the user to the chat server.” Paper No. 20051123 at page 4. Applicants submit that identification of a client applet to a chat server, as apparently taught at Barrett Col. 5, Lines 4-8, is not “receiving a first comment from the first user” because claim 1 continues to recite that the comment is provided to a second user along with the identified media object and there is no teaching in Barrett to supply the client application identification to a second user. At least for this reason, Applicants submit that a client applet identifying to a chat server would not be a comment entered by a first user and provided to a second user with a media object.

Finally, Applicants submit that Barrett does not teach, “receiving a reply comment from the second user wherein the first user and the second user are not connected to an instant messaging session.” Barrett Col. 5, Line 65 – Col. 6, Line 28 shows this to be the case, “a communication grouping is established when the activities of a client computer matches the activities of one or more other companion client computers...client computers 12 in a communication grouping then communicate with other companion computers in the same grouping.” Thus, it is abundantly clear that Barrett contemplates establishing a grouping before communication among group members. By contrast, in claim 1, a comment from a first user is provided to a second user before connection in an instant messaging session.

Schtivelman

The Examiner appears to rely on Schtivelman as teaching automatically connecting users in an instant messaging session if a reply comment fits a matching criteria. The Examiner cites Col. 13, Lines 7-17 and Col. 2, Lines 25-42 of Schtivelman as disclosing “an interactive chat communication system includes the rules governing criteria for selecting a query/response pair and automatically assign chat session.”

Schtivelman at Col. 13, Lines 7-17 teaches, “[a]fter a query is parsed and matched...SW 112 looks for associated responses...Standard queries and responses may, in one embodiment, be derived from researching threaded chat histories stored in repository 105. Rules governing criteria for selecting a query/response pair as a standard query/response pair may be as simple as setting a frequency threshold in a specific chat session dialog that indicates how often the query is posted and responded to over any given period of time such as during one session length.” Applicants thus submit that in this section, Schtivelman teaches matching queries and responses and maintaining histories in previous chat sessions.

Schtivelman at Col. 2, Lines 25-42 teaches “agents to be automatically assigned, relieved, and reassigned to communication-center chat sessions and other hosted participatory sessions based on message load and skill set.” Applicants submit that this section of Schtivelman teaches assigning, relieving, and reassigning agents hosting chat sessions based on message load and skill set.

Other portions of Shtivelman teach “a system for extracting keywords from interactive text dialog and providing the extracted keywords as a dialog summary.” Shtivelman Abstract. See also representative Fig. 2, relating to agent reassignment, Fig. 3, relating to agent release and Fig. 6 relating to query/response.

From the above, Applicants submit that Shtivelman (1) analyzes previous communications to extract keywords, (2) establishes standard query/responses and (3) automatically assigns, reassigns, and relieves agents hosting communication sessions.

Applicants submit that Shtivelman does not teach or suggest “if the reply comment fits a matching criteria, automatically connecting the first and the second user in an instant messaging system” because Shtivelman operates with existing dialogs, histories of past sessions, and assigns/reassigns agents to host ongoing dialogs and does not seek to establish communication between a first user and a second user automatically upon a reply comment from the second user to the first meeting a matching criteria.

In conclusion, Applicant submit that Barrett and Shtivelman do not in any combination teach or suggest each and every limitation of claim 1, as is required for a rejection under 35 U.S.C. 103. Therefore, Applicants respectfully request withdrawal of the rejection against claim 1.

Claim 2:

Regarding claim 2, the Examiner cites Shtivelman Col. 16, Lines 10-21 as disclosing “the matching criteria is in the form of an approval indication.” Lines 10-21 first disclose, “incoming messages are received and parsed.” This section shows that Shtivelman is inapplicable to the present claims, because there are “incoming messages” in these actions taught in Shtivelman, which means that a communication session has already been established. Claim 1 however recites that there is instant messaging session yet established between users. In claim 1 above, the first and second users are not connected until the reply comment fits the matching criteria.

Further, there is no teaching of “an approval indication by the first user of the reply comment” as recited in claim 2. Therefore, Shtivelman does not disclose the additional recitations

of dependent claim 2. Claim 2 is therefore allowable by virtue of dependency from claim 1 and these additional recitations.

Claim 3:

After reviewing the cited section of Barrett (Col. 4, Lines 53-65), it is difficult to see how Barrett discloses “the media object includes one, or a combination, of a video clip, a graphic or a text object” because this portion of Barrett describes a client proxy modifying web pages by adding Javascript and/or Java applets to them.

Applicants respectfully submit that this is further evidence that Barrett does not disclose a “media object” as recited in claim 1, or as further limited in claim 3. Claim 3 is therefore allowable by virtue of dependency from claim 1 and these additional recitations.

Claim 4:

Applicants submit that it has been shown that Barrett-Shtivelman do not teach the limitations of claim 1, and therefore Barrett-Shtivelman cannot teach the limitations of claim 4, as they are essentially replicating many of the claim 1 limitations with regard to additional users. Claim 4 is therefore allowable by virtue of dependency from claim 1 and these additional recitations.

Claims 7-11

Applicants submit that each of claims 7-11 include patentably distinguishing limitations from what is disclosed or suggested in Barrett-Shtivelman.

For example, the Examiner alleges that Barrett at Col. 5, Lines 37-47 discloses “a plurality of media objects are associated with nodes in a hierarchical topic network...” However the cited section of Garrett teaches, “When a user right-clicks on an icon 50, a pop-up menu 52 can appear as shown in FIG. 5. It can be appreciated in reference to FIG. 5 that the pop-up menu 52 can be selected to show further data regarding the client computer 12 represented by the clicked-on icon

50..." It is difficult to see how this section teaches the additional limitations of claim 8, given that there no apparent disclosure of media objects associated with nodes in a hierarchical topic network.

Each of these claims also depends directly or indirectly from claim 1. Each of claims 7-11 is therefore allowable over Barrett-Shtivelman by virtue of this dependency and by virtue of additional distinguishing features.

Claim 12

Claim 12 recites patentably distinguishing limitations similar to those of claim 1. The Examiner has cited the same sections of the same prior art references in rejecting claim 12. Applicants submit that claim 12 is patentable over any combination of Barrett-Shtivelman for at least the reasons discussed with respect to claim 1. Applicants respectfully request withdrawal of the rejection against claim 12.

Claims 13, 14, and 17-21:

Each of these claims contains additional limitations paralleling limitations of claims 3, 4, and 7-11. As with those claims, these additional limitations further patentably distinguish the present claims from Barrett-Shtivelman. Applicants submit that these claims are allowable by virtue of dependency from claim 12 and by virtue of these additional limitations.

Claims 22 and 23:

Applicants submit that claims 22 and 23 are allowable at least by virtue of dependency from claim 12.

Claim 24:

Claim 24 differs from claims 1 and 12 principally in that claim 24 recites, “providing the media object and a link to the first comment for display to the plurality of users.” Applicants submit that this limitation is not taught or suggested in any proposed combination of references. Applicants also submit that parallel limitations, discussed with respect to claim 1 are also not taught or suggested presently cited references, and that claim 24 is therefore allowable over Barrett-Shtivelman.

Claims 1-4, 7-14, 17-25, 27-28 are rejected under 35 U.S.C. §103 as being allegedly unpatentable over Olivier et al [Olivier 6,400,885 B1] in view of Appelman et al [Appelman 6,539,421 B1].

The Applicants note that the Examiner cited Olivier as being U.S. Patent No. 6,400,885; the Applicants assume that the Examiner meant Olivier 6,480,885 and proceed accordingly.

The Examiner cited Col. 25, Lines 20-40 of Olivier as disclosing “providing a media object to be displayed to a first user” where an “object ID” is taught at Olivier Col. 6 Lines 63-67. Paper No. 20051123 at page 9. Applicants submit that the “object ID” is “a database record’s unique ID” Olivier Col. 6, Lines 63-64. Applicants further submit that Olivier neither teaches that this “object ID” is provided “to be displayed to a first user” as the media object of claim 1, nor that this “object ID is further “provided to be displayed to a second user along with [a] first comment [from the first user].” Applicants submit that Olivier thus does not teach a “media object” according to claim 1.

Olivier Col. 3, Lines 55-60 was cited as teaching “receiving a first comment from the first user.” Col. 3, Lines 55-60 include a stated object/advantage of the Olivier invention, “provide[s] a way of filtering archived information...this includes email archives...such as recommended businesses.” Applicants submit that this section cannot teach “receiving a first comment from the first user” because the “first comment” in claim 1 is provided with the media object to a second user, and this citation from Olivier appears to teach nothing similar.

For teaching, “providing the media object to be displayed to a second user along with the first comment” the Examiner cited the “object ID” and meta-subscription at Col. 19, Lines 17-30. The “object ID” was discussed above and need not be re-addressed. Regarding meta-subscription,

this is “the option of combining two or more subscriptions into one “meta-subscription” that appears as one mailing list in her email box.” It is difficult to see how “meta-subscription” teaches anything relating to providing a media object to a second user along with a first comment.

The Examiner cited a variety of other sections in Olivier as teaching “receiving a reply comment from the second user wherein the first user and the second user are not connected to an instant messaging session.” All of these Olivier sections deal with subscribing to e-mail lists based on criteria such as age, location, interests, and the like. Olivier thus teaches deciding to join an e-mail list based on various criteria, and if joined then receiving and sending messages in that list. As such, Olivier does not teach a “reply comment” because there is no “media object to be displayed to a second user along with the first comment” in Olivier for which a “reply comment” could be responsive.

For at least all these reasons, Applicants submit that Olivier-Appelman does not teach or suggest the limitations of claim 1, and that claim 1 is therefore allowable over Olivier-Appelman. Applicants respectfully request withdrawal of the rejection against claim 1.

Claims 2-4, and 7-11:

As discussed with reference to claim 1, no combination of Olivier and Appelman disclose all the limitations of claim 1, and more particularly, Olivier-Appelman do not disclose the method steps using the “media object” and “comment[s]” sent and received between users prior to establishing an instant messaging session. Claims 2-4 and 7-11 provide further refinements to aspects relating to objects and comments. Therefore, Olivier-Appelman would not teach or suggest these further limitations. Therefore, claims 2-4 and 7-11 are allowable over Olivier-Appelman based on respective additional recitations in those claims and based on dependence from claim 1.

Claim 12:

Claim 12 was also rejected over a proposed combination of Olivier and Appelman. Sections of Oliver that were cited in claim 1 were also cited here for the same teachings. For example,

“object ID” and “meta subscription.” As discussed above, these aspects of Olivier do not teach the method steps of claim 12 relating to “media objects” and “comments” for many of the same reasons. Applicants request withdrawal of the rejection against claim 12.

Claims 13-14, 17-21:

These claims contain comparable limitations to claims 3-4 and 7-11. Claims 13-14 and 17-21 are allowable for at least the reasons discussed with respect to 3-4 and 7-11, with a difference being that claims 1-14 and 17-21 depend from allowable claim 12 instead of allowable claim 1.

Claims 22-23, 25, 27, 28:

In rejecting claims 23, and 25, the Examiner did not provide any particular citations to sections of Olivier-Appelman.

Each of claims 22-23, 25, 27, 28 recites additional subject matter not taught or suggested in Olivier-Appelman at least because Olivier-Appelman do not teach methods steps involving “media objects” and “comments” according to independent claims 12 and 24, and that therefore Olivier-Appelman could not teach refinements on any of those concepts.

Each of these claims is also allowable by virtue of dependency from allowable independent claims 12 and 24. Withdrawal of the rejection against each claim is respectfully requested.

Motivation to combine Olivier and Appelman:

The Examiner has proposed combining Olivier, which relates to establishing e-mail lists based on various criteria with Appelman, which relates to a “messaging application user interface...to allow a user to send instant messages to and exchange comments with a plurality of users without having to switch among several instant message windows.” Appelman Abstract. Olivier’s e-mail lists and Appelmans improvement on an instant messaging user interface are in

different fields of endeavor, not the same field of endeavor, since e-mail and instant messaging are related only in the coarse sense that each are electronic means for communication which is not a sufficient relationship to consider them in the same field of endeavor.

The Examiner further cited “auto-completion” in Appelman as curing the deficiency that Olivier does not teach “if the reply comment fits a matching criteria, automatically connecting the first and the second user in an instant messaging system.” However, “auto-completion” in Appelman is “automatically completing the address of a message based on a partially entered address...thereby saving time and effort.” Col. 3, Lines 45-47. Applicants submit that auto-completion of Appelman has nothing to do with automatically connecting users upon a reply comment fitting a matching criteria.

And, if “auto-completion” of Appelman were combined with Olivier, the resulting system would be an e-mail list system where e-mail addresses would automatically complete, which is still not a system that renders claim 1 obvious by teaching and/or suggesting all the limitations of claim 1.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 324212007201. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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